In the Supreme Court of the United States

OCTOBER TERM, 1968

No. 415

ROBERT J. EBBERT AND DESIGN PRODUCTS CORPORATION, PETITIONERS

v.

EDWARD J. BRENNER, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

By "Notice of Allowance and Issue Fee Due" dated April 21, 1966, petitioners were notified (1) that their application for a patent had been allowed and (2) that, as a prerequisite to its issuance, an issue fee must be paid "within three months of the date of this Notice or the Patent will become abandoned (forfeited)" (Pet. 19). However, because of a clerical error by petitioners' counsel, timely payment was not

made.[1] The patent application was accordingly deemed abandoned under 35 U.S.C. (Supp. I) 151 (Pet. 3).

On February 10, 1967, almost seven months after it was due, the issue fee was tendered to the Commissioner of Patents, who rejected it on the ground that there was no statutory authority for the acceptance of a fee tendered after October 21, 1967—the expiration date of the three-month grace period provided by Section 151 (Pet. 13-14).[2] Petitioners then brought suit in the district court to compel acceptance of the fee and the issuance of the patent. The district court granted the relief (Pet. 15-17), but the court of appeals reversed (Pet. 18-25).

Petitioners' contention here is that the action of the Commissioner—and that of the court of appeals in upholding it—constitutes a deprivation of property without due process of law. The court of appeals correctly held, however, that the notice sent by the Patent Office, and concededly received by the petitioners, "fully satisfied due process requirements" (Pet. 23). The court applied the settled principle that notice satisfies due process if it is "reasonably calculated" to apprise parties of actions which they must take and gives a reasonable time for these actions to be taken. *Mullane* v. *Central Hanover Bank & Trust Co.*, 339 U.S. 306, 314-315. In this case, the notice plainly ap-

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[1] The fee was paid in another pending application by mistake (Pet. 27).

[2] Section 151 gives the Commissioner of Patents authority to accept late payment and revive the patent application *nunc pro tunc* if two conditions are met. First, the issue fee must be tendered within three months of the due date. Second, "sufficient cause" must be shown for the late payment.

prised petitioners (1) that the issue fee had to be paid within three months, and (2) that the application would be forfeited for non-payment. Indeed, failure to make payment here was caused, not by any deficiency in the notice, but by an error by petitioners' counsel. See *Link* v. *Wabash Railroad Co.*, 370 U.S. 626, 633-634.[3] As stated by the court below, "[t]he Constitution requires notice reasonably designed to forewarn against approaching default; but it does not insure against the effects of a mistaken response to timely notice knowingly received" (Pet. 24).

The petition for a writ of certiorari should be denied.

Respectfully submitted.

ERWIN N. GRISWOLD,
Solicitor General.

SEPTEMBER 1968.

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[3] Contrary to petitioners' suggestion, the suspension of the Patent Office practice of notifying applicants of forfeitures did not vitiate the effectiveness of the original notice which petitioners concededly received. The Patent Office is not required to reiterate that an application has been forfeited after it has given adequate notice of the impendency of such forfeiture in the earlier "Notice of Allowance and Issue Fee Due".

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